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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,735	03/30/2007	Wilhelm Bubits	4331.75224	1248
24978 7590 04/03/2008 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER				
CLEMENT, MICHELLE RENEE				
ART UNIT		PAPER NUMBER		
3641				
MAIL DATE		DELIVERY MODE		
04/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,735

Applicant(s)

BUBITS, WILHELM

Examiner

Michelle (Shelley) Clement

Art Unit

3641

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, in claim 1, "the magazine comprising a lug on its front wall, in the front part of the pistol grip" is grammatically incorrect in that it is not clear what is in the front part of the pistol grip; "in which middle position the lug of the magazine" is unclear in that the claims have not set forth the lug being in a middle position nor does the specification indicate the lug being moveable into any additional (transverse) positions. Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation (See MPEP 608.01(i)(i)).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, as the examiner best understands them, are rejected under 35 U.S.C. 103(a) as being unpatentable over Roemer (US Patent # 2,305,033) in view of Smith (US Patent #

4,747,224). Roemer discloses a firearm which receives a magazine for rounds insertable from below, the magazine, when completely inserted, being retained in the firearm;

The magazine comprising a lug on its front wall, in the front part,

A sliding block is arranged for displacement in a transverse direction, the sliding block is held in a middle position by at least one spring,

The lug rests on the sliding block when the sliding block is in the middle position,

The sliding block having respective vertical grooves on each side of the lug,

By displacing the sliding block in either one of two directions, the groove can be brought into the path of the movement of the lug when inserting the magazine.

One of the two grooves widens downwardly (Figure 7) so that, at its lower end, it extends into a path of movement of the lug during insertion of the magazine, wherein the lug temporarily moves the sliding block out of its middle position, against the force of the at least one spring. The lug is attached by notching and bending out.

Although Roemer does not expressly disclose the firearm and magazine in a pistol with a hollow pistol grip and the two bar springs, Smith does. Smith teaches a pistol with a hollow pistol grip which receives a magazine and a magazine catch that is displaceable to the right and left in transverse motion. Wherein the sliding blocks are held in its middle position by two counter-acting bar springs which are approximately vertically mounted in the interior of the pistol grip and stop faces provided in the interior of the pistol grip which delimit the path of the bar springs. Because both references teach magazine catches, it would have been obvious to one skilled in the art to substitute one type of spring and magazine placement (i.e. in the hollow grip) for the other to achieve the predictable result of providing a more reliable ambidextrous magazine release. In

regards to claim 6, it is noted that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps; “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 227 USPQ 964. Regarding the process for making the claimed lug or the **Product by Process** Claims, applicant is direct to MPEP § 2113 cited in the prior office action. Therefore the lug of the magazine being produced by injection-moulding is not pertinent in this instance to the patentability of this product claim.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roemer and Smith as applied to claim 1 above. Roemer and Smith disclose the claimed invention except for the lug made of a material that is resiliently elastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lug of a resiliently elastic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 12 5USPQ 416.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/
Primary Examiner, Art Unit 3641